

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Adnan M.M. Mjalli et al.
Ser. No. : 10/091,759
Filing Date : March 5, 2002
For : CARBOXAMIDE DERIVATIVES AS THERAPEUTIC
AGENTS
Examiner : Puttlitz, Karl J.
Art Unit : 1621
Atty. Docket : TTP 2001-21-US-A

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Remarks Supporting Petition To Revive An Application For Patent
Abandoned Unintentionally Under 37 CFR § 1.137(b)

Sir:

Applicants submit herewith a Petition To Revive An Application For Patent Abandoned Unintentionally Under 37 CFR § 1.137(b) and the following remarks supporting Applicants' statement that the entire delay in filing the required response between due date for the required response until the filing of a grantable petition under 37 CFR § 1.137(b) was unintentional.

Prosecution History

1. During prosecution of the present application, the Examiner mailed a non-final Office Action on July 19, 2006.
2. The Examiner set a shortened statutory deadline for filing a response of 3 months from the mailing date of the Office Action, with extensions available up to 6 months from the mailing date of the Office Action. Thus, the 6 month deadline for filing a response was Friday, January 19, 2007.

3. A response to the non-final Office Action and a petition for a 3 month extension of time was delivered to the USPTO by the "Express Mail Post Office to Addressee" service of the US Postal Service (USPS).
4. The Express Mail label EV 841058421 US (Exhibit A) was attached to the sealed envelope containing the response and petition for extension of time.
5. As evidenced by the attached Express Mail label (Exhibit A), the envelope containing the response and petition for extension of time was deposited with the USPS on Monday, January 22, 2007.
6. As evidenced by the attached USPS track and confirm data (Exhibit B), the envelope containing the response and petition for extension of time was received by the Office of Initial Patent Examination on January 23, 2007.
7. Under 37 CFR § 1.10 (a)(1), when using the Express Mail service of the USPS, the date of filing with the USPTO is the date of deposit with USPS. Accordingly, the Office of Initial Patent Examination date stamped "January 22, 2007" on the Express Mail Certificate coversheet included in the envelope containing the response and petition for extension of time. (Exhibit C). Thus, the response and petition for extension of time were filed with the USPTO on January 22, 2007, and were not timely filed within 6 months of the mailing of the Office Action on July 19, 2006.
8. The Express Mail Certificate coversheet included in the envelope containing the response and petition for extension of time was prepared by Christine Heerschap and the coversheet incorrectly states that the envelope containing the response and petition for extension of time was deposited on January 19, 2007.
9. The USPTO did not deem the application abandoned for failure to file a timely response to the Office Action mailed July 19, 2006, even though

the response and petition for extension of time were filed after the 6 month due date.

10. Prosecution has continued in the application until a Notice of Allowance was mailed October 17, 2007.

Statements Regarding Delay In Filing Response To Office Action

1. On January 3, 2007, Samuel B. Rollins, the attorney who drafted the response, communicated to Christine Heerschap, a filing assistant, to prepare the response for filing and to submit the response and a petition for 3 month extension of time by the deadline of January 19, 2007. (Exhibit D).
2. As evidenced by the date of Samuel B. Rollins' signature on the response and petition for extension of time, the response and the petition for extension of time were completed and ready for filing on January 16, 2007.
3. The Express Mail Certificate coversheet prepared by Christine Heerschap and included with the response and petition for extension of time, incorrectly states that the Express Mail envelope was deposited with the USPS on January 19, 2007. (Exhibit C).
4. The Express Mail envelope containing the response and petition for extension of time was deposited with the USPS on January 22, 2007 as evidenced by the attached Express Mail label (Exhibit A).
5. At the time of filing the response and the petition for extension of time and until the recent review of the file history to check patent term adjustment (PTA) calculations, neither Applicants, Samuel B. Rollins, nor Christine Heerschap recognized that the response and petition for extension of time were not timely filed and that the Express Mail Certificate coversheet

incorrectly states that the Express Mail envelope was deposited with the USPS on January 19, 2007. Thus, the delay between January 19, 2007, and January 22, 2007, in filing the response and petition for extension of time was unintentional.

Statements Regarding Delay In Filing A Grantable Petition to Revive The Unintentionally Abandoned Application

1. As stated above, the delay between January 19, 2007, and January 22, 2007, in filing the response and petition for extension of time was unintentional.
2. The delay in filing a grantable petition from January 22, 2007 until the filing of this petition was also unintentional.
3. Up until the week of December 3, 2007, neither Applicants, Samuel B. Rollins, nor Christine Heerschap recognized that the response and petition for extension of time were not timely filed and that the Express Mail Certificate coversheet (Exhibit C) incorrectly states that the Express Mail envelope was deposited with the USPS on January 19, 2007. The actual date of deposit of was January 22, 2007 as shown on the Express Mail label (Exhibit A).
4. Samuel B. Rollins became conscious of the discrepancy and error while making preparations to pay the issue fee in the application prior to the deadline of January 17, 2008. Specifically, Samuel B. Rollins became conscious of the discrepancy while checking the PTA calculation provided by the USPTO.
5. Once Samuel B. Rollins and Applicants became aware of the discrepancy, preparations immediately began to draft and file the attached Petition To Revive.

Conclusion

1. The present application was unintentionally abandoned for failure to timely respond to the Office Action mailed July 19, 2006.
2. Applicants respectfully request the grant of the attached Petition To Revive An Application For Patent Abandoned Unintentionally Under 37 CFR § 1.137(b).
3. The response to the Office Action mailed July 19, 2006 was filed on January 22, 2007, along with a petition for a 3 month extension of time.
4. No terminal disclaimer is needed because this application was filed after June 8, 1995.
5. Authorization for the petition fee of \$ 770.00 (small entity) under 37 CFR § 1.17(m) is provided on the attached form PTO/SB/64. Should any additional fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. **50-4060**.

Respectfully submitted,

Date: 21-December-2007

/Samuel B. Rollins/
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Encl. - Exhibit A - Copy of Express Mail label EV 841058421 US
Exhibit B - USPS track and confirm data for EV 841058421 US
Exhibit C - Copy of Express Mail Certificate coversheet prepared by Christine Heerschap for EV 841058421 US
Exhibit D - Copy of January 3, 2007 communication from Samuel B. Rollins to Christine Heerschap